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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,927	03/31/2004	Sridhar Varadarajan	4544-043812	7917

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Richard L. Byrne
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1818

EXAMINER

BOTTS, MICHAEL K

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/814,927	Applicant(s) VARADARAJAN ET AL.	
	Examiner Michael K. Botts	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/12/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This document is the First Office Action on the merits. This action is responsive to the following communications: The Non-Provisional Application, which was filed on March 31, 2004.
2. Claims 1-16 have been examined, with claims 1 and 15 being the independent claims.
3. The Abstract is objected to.
4. Claims 1-16 are rejected.

Information Disclosure Statement

5. A signed and dated copy of applicant's IDS, which was filed on July 12, 2004, is attached to this Office Action.

Abstract of the Disclosure

6. The abstract of the disclosure is objected to because it is in excess of 150 words in length. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claims Rejections – 35 U.S.C. 112, First Paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. **Claims 1-16** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, without undue experimentation.

Independent claim 1 states in the preamble "A system for automatic generation of presentations" There is no disclosure in the specification supporting a system for automatically generating a presentation. The specification describes general steps in an algorithm involving preparation of a presentation, but there is no disclosure supporting the "automatic" generation such that one of ordinary skill in the art at the time of the invention would be taught to make and use the invention without undue experimentation. Similarly, independent claim 15 recites as follows: "A network based system for automatic generation of presentation"

As an example of the human intervention which seems to preclude claiming an "automatic" system, see figure 3a, and disclosure, page 8, lines 24-27, stating as follows: *"FIG. 3a describes a typical workflow related to APG system. The workflow depicts the activities performed by a user and the major functions of the subsystems of APG system and indicates draft presentation generation and tuning, and the role of best presentations in template generation."* Further, it is noted that throughout the specification, the user is called upon to make quality decisions regarding the form and content of the presentation. For example, see, disclosure, page 10, lines 22-24, stating: *"And both text and graphics are annotated appropriately to capture the salient aspects of the slide. Note that these annotations are done manually and are associated with the slide."* See also, disclosure, page 15, lines 4-8, stating: *"FIG. 15 describes the procedure for the interactive tuning of the generated draft version of a presentation by a user. The input for interactive tuning process is the draft version of a presentation and this process results in the generation of the final version of the presentation (1500). The user analyzes the draft presentation slide by slide and performs Steps 1504 through 1510 for each slide (1502)."*

8. In the interest of compact prosecution, the application is further examined against the prior art, as stated below, upon the assumption that the applicants may overcome the above stated rejection under 35 U.S.C. 112, first paragraph.

Claims Rejections – 35 U.S.C. 112, Second Paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Independent claims 1-16** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 provides for the use of "a presentation organizer subsystem," "a presentation tuning subsystem," "a template generation subsystem," "an analogical examples management subsystem," "a template management subsystem," and "an annotation subsystem," but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 15 provides for the use of "(a) a network for interconnecting said plurality of automatic presentation generation systems; and (b) a presentation coordinator subsystem for managing interconnection of said plurality of automatic presentation generation systems," but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Dependent claims 2-14 and 16 inherit the deficiencies of independent claims 1 and 15, respectively, by virtue of their dependencies.

Additionally, claim 16 recites the limitation "said plurality of automatic presentation generation systems" in lines 5-6 and 7-8. There is insufficient antecedent basis for this limitation in the claim. Although the term "plurality of automatic presentation generation systems" appears in the preamble, the preamble is not read into the claim.

10. In the interest of compact prosecution, the application is further examined against the prior art, as stated below, upon the assumption that the applicants may overcome the above stated rejection under 35 U.S.C. 112, second paragraph.

35 U.S.C. 112, Sixth Paragraph

11. **Claims 2-14 and 16** fail to invoke 35 U.S.C. 112, sixth paragraph.

A claim limitation will be interpreted to invoke 35 U.S.C.112, sixth paragraph, if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase "means for" or "step for;"
- (B) the "means for" or "step for" must be modified by functional language' and
- (C) the phrase "means for" or "step for" must not be modified by sufficient structure, material or acts for achieving the specified function.

See, MPEP 2128(1).

Dependent claims 2-14 and 16 meet the first two prongs of the 3-prong analysis – using the phrase “means for” with such “means for” modified by functional language. However, the claims fail the third prong of the analysis in that the “means for” is “modified by sufficient structure, material or acts for achieving the specified function.” Specifically, the structure and acts specified in the claims following the term “comprising” are sufficient to achieve the specified “means for” function.

For example, in claim 2, the claim meets the first prong of the analysis, using the phrase “means for.” Claim 2 also meets the second prong of the analysis, in that the “means for” phrase is modified by functional language, specifically “means for processing of an agenda.” However, the claim fails the third prong of the analysis in that the phrase “means for processing of an agenda” is followed by sufficient acts for achieving the function of “processing an agenda.”

Specifically, the claim recites the following steps: *“format verification of said agenda, consistency verification of said agenda, analysis of client information o said agenda, analysis of audience information of said agenda, and analysis of presentation information of said agenda.”* After following all of the steps specified in the claim, the agenda would be processed, and there is no purpose in relying on 35 U.S.C. 112, sixth paragraph.

It is noted that the Applicants may be able to properly invoke 35 U.S.C. 112, sixth paragraph if the claims are amended to remove the recitation of the acts for achieving the specified functions, provided there is sufficient support for the means in the specification. See, MPEP 2181-2186.

Claims Rejections – 35 U.S.C. 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. It is noted that independent claims 1 and 15 claim a “system” comprising a series of “subsystems,” with each subsystem claiming steps for use of the subsystem.

Dependent claims 2-14 and 16 specify steps of the subsystem. Because the “system” is ultimately comprised of a series of steps, the system claims are read as claims to methods.

13. **Claims 1-15** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Independent claims 1 and 15 specify a series of disconnected subsystems that produce no useful, concrete, or tangible result. In order for a claimed invention to accomplish a practical application, it must produce a “useful, concrete and tangible result” State Street, 149 F.32d at 1373, 47 USPQ2d at 1601-02 (see, MPEP 2106.II.A).

For example, as specified in claim 1, the subsystems are specified as having a purpose, but not in accomplishing that purpose, i.e.: “subsystem for analyzing input,” “subsystem for interactively tuning,” “subsystem for interactively generating,” or “subsystem for managing.” The subsystems are identified, but they are not claimed as actually doing anything. The subsystems exist separately such as parts in a kit, without

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being combined to achieve a useful, concrete, or tangible result. By analogy, an automobile may be described as a system comprising subsystems for steering and locomotion, but so long as the steering and the engine remain separate on the garage floor, there is no automobile.

Similarly, independent claim 15 specifies “a network for interconnecting” the presentation generation system, and a “presentation coordinator subsystem for managing interconnection.” There is no result claimed from specifying these two components.

Dependent claims 2-14 do not remedy the grounds for rejection. For example, independent claim 1 specifies “an agenda management element for managing agendas.” See, claim 1, lines 4-5. Dependent claim 3 purports to further limit the “agenda management element” as a “means for processing of an agenda comprising format verification of said agenda, consistency verification of said agenda, analysis of client information of said agenda, analysis of audience information of said agenda, and analysis of presentation information of said agenda.” Applicants merely add more disjointed elements to the limitation of an “agenda management element,” but do not claim a useful, concrete, or tangible result from the steps. Similarly, claims 3-14 also list additional steps purportedly related to different elements of claim 1, but which do not result in a useful, concrete, or tangible result.

It is noted that this objection may be obviated by proper amendment to clearly claim a concrete, useful, or tangible result from the combination of the subsystems.

14. In the interest of compact prosecution, the application is further examined against the prior art, as stated below, upon the assumption that the applicants may overcome the above stated rejections under 35 U.S.C. 101.

Claims Rejection – 35 U.S.C. 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. It is noted, as set forth in rejections above, that the application merely claims a series of systems with broad general claims for uses, no specific disclosure such as to teach one of ordinary skill in the art how to make or use the invention without undue experimentation, and claims no concrete, useful, or tangible result.

16. Given the broadest reasonable interpretation to the myriad of loosely defined systems, the Examiner finds that there are many different ways of creating the applicant's invention, as claimed. The specification provides no definitional assistance in narrowing the limitations. Accordingly, in the interest of compact prosecution and art-based examination, the following rejections are based on a possible interpretation of the pending claims as generally directed to a system or method of generating or preparing a presentation, including the following elements drawn from the claim limitations:

- a. an agenda;
- b. audience evaluation;
- c. a presentation template;
- d. a draft of the presentation;
- e. a revision of the draft presentation;
- f. analogies for use in the presentation; and
- g. slides for use in the presentation.

It would have been obvious to one of ordinary skill in the presentation art at the time of the invention that from the elements above, the elements could be related in what could be labeled as sub-systems, and that the combination of the sub-systems would produce a presentation. Said system of sub-systems, under the broadest reasonable interpretation, would have been obvious to one of ordinary skill in the art at the time of the invention.

17. Accordingly, **claims 1-16** are rejected under 35 U.S.C. 103(a) as being obvious over Chial, Michael R., Ph.D., "Tips for Building Computer-Based Presentations," University of Wisconsin – Madison, copyright 2002 [hereinafter "Chial"].

Chial teaches the elements of claims 1-16 as follows:

an agenda:

See, Chial, page 2, section 2, "Agenda."

audience evaluation:

See, Chial, page 2, section 2, under "Goals."

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a presentation template;

See, Chial, page 4, section 2.A., "Pick a template."

a draft of the presentation;

See, Chial, pages 4-5, section D, "Polish your work for emphasis."

a revision of the draft presentation;

See, Chial, page 5, section E, "Edit your work."

analogies for use in the presentation; and

See, Chial, page 3, section E, teaching using alternative presentations for effect.

slides for use in the presentation.

See, Chial, page 1, second paragraph, teaching computer generated slides.

18. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art.

See, MPEP 2123.

Conclusion

19. The following prior art is made of record and not relied upon that is considered pertinent to applicants' disclosure:

Hamm, Patricia Hogan, PhD., "Teaching and Persuasive Communication: Class Presentation Skills," published on the Web at least as of March 13, 2003, last

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downloaded by the Examiner on August 1, 2006, from:

http://web.archive.org/web/20030213024822/http://www.brown.edu/Departments/Italian_Studies/dweb/pedagogy/class-pres-skills.shtml.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael K. Botts whose telephone number is 571-272-5533. The examiner can normally be reached on Monday through Friday 8:00-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Heather R. Herndon
Supervisory Patent Examiner
Technology Center 2100